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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,764	12/21/2004	Harad Syse	P18235USPC	4976

7590 03/09/2007
GABEL GOTWALS
100 WEST 5TH STREET 10TH FLOOR
TULSA, OK 74103

EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
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3754

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/518,764

Applicant(s)

SYSE, HARAD

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

With regards to the request correct the inventor's first name such cannot be done by the examiner. From closer examination, applicant misspelled the typed version of the applicants first name in the Oath and the spelling used is where the Oath is signed and such was the incorrect spelling, therefore a new oath would be required to correct the inventorship along with a formal request to change the spelling of the applicant's first name. Such is not done by the examiner and cannot be done without a proper Oath. It is also noted that the patent to Syse 7,124,779 also lists the applicant's first name with the same spelling as is set forth in the instant application. If this truly is a misspelling applicant may want to correct the patent to Syse as well, but such also will have to be done according to MPEP procedures.

Specification

The amendment filed December 4, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the axial bore through the piston rod "from end to end" is not supported by the original specification as filed. A bore is set forth through the piston rod but the specification does not appear to describe that the bores in the piston rod extend from end to end. This subject matter cannot be ascertained from the specification or figures as originally filed and therefore such is new matter.

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Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The axial bore through the piston therethrough from end to end is set forth in the specification as originally filed, and such is considered new matter based upon the objection above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Campbell (384). The patent to Campbell discloses the recited plug comprising a main section near 68, at least one hydraulic cylinder with bore 70, fastening devices 24, 26, sealing surfaces 86, 78, a piston rod 76 which goes through end plates 86,78, and that the ends

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are shown to have some manner of connecting elements provided thereon such as the bolt over the rod end surrounded by spring 22, there are bores within the piston rod for the flow of at least gas and/or liquid and would be capable of carrying cables as well, where the method of utilizing such as a plug which has slips 26 and sealing arrangement formed by member 24 reacting to the movement of wedges such as 130 which are connected to the slips 26 such that the slips and member 24 will engage the inside of the pipe as it is actuated. As can be seen, the movement of the piston actuates member 130 which is connected to slips 26 to engage those with the pipe wall as well as move the plate with wedge 120 to expand out the seal member 24, therefore the plug to Campbell meets the claimed method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell (384) in view of Campbell (651). The 384 reference discloses all of the recited structure with the exception of forming the axial bore such that it passes end to end with respect to the ends of the piston rod. The 651 reference shows that it is known to form the piston rod generally shown as the body passing through the center of the plug assembly 44 defined as a rod which has piston surfaces formed thereon is provided with at least one passageway 90 that extends end to end within the rod and the rod is attached to

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plates at the ends, where another embodiment shown has a piston rod that has axial bores that exit to the peripheral side much the same as the 384 reference thereby teaching that it is old and well known to form the axial bores in the piston in either configuration. It would have been obvious to one skilled in the art to modify the bore in Campbell 384 by modifying the axial bores to extend to the ends of the piston rod as suggested by Campbell 651 where such is an equivalent manner to form the axial bores in the piston and such would allow for easier connections which would not be as stressed as tangential connections which would be more easily damaged as the plug is moved through the pipeline.

Response to Arguments

Applicant's arguments with respect to claim 8 has been considered but is moot in view of the new ground of rejection. With respect to claim 9, the arguments of December 4, 2006 are not persuasive where the arguments merely state that the reference to Campbell does not recite the claimed structure but fails to elaborate, and the reference to Campbell as described above still is considered to meet the method as it is currently claimed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Syse disclosing background art that is related to the instant application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

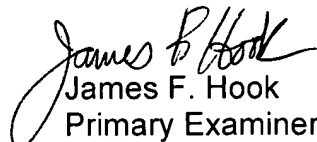
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


James F. Hook
Primary Examiner
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JFH